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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,935	12/30/1999	Ilya Umansky	14013-32CIP	2956

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LAW OFFICES OF IMAM  
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SAN JOSE, CA 95113

EXAMINER

TRAN, PHUC H

ART UNIT PAPER NUMBER

2666

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/474,935

Applicant(s)

UMANSKY, ILYA

Examiner

PHUC H TRAN

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Drawings*

1. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### *Claim Objections*

2. Claim 1 is objected to because of the following informalities: “the first fax pages” in lines 7 is insufficient antecedent basis for this limitation in the claim; “at least one of the first fax pages of the fax document” in lines 8 is not clear the number of the first fax page in one fax document. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 3-6, 9-12, 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Regarding to claim 3, “the router further for retransmitting the secondary email packets to the more than one recipient fax machine” in lines 2-3 is not described in the specification in such a way to reasonably convey to one skill in the relevant art.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 3-6, 9-12, & 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 3 recites the limitation "the second mails packets" in line 3. There is insufficient antecedent basis for this limitation in the claim.

- Regarding to claim 3, "for retransmitting the secondary email packets" in lines 2-3 is not clear what condition for the retransmitting and why to more than one fax machine.

- Claim 4 recites the limitation "the failed fax pages" in line 2. There is insufficient antecedent basis for this limitation in the claim.

- Claim 5 recites the limitation "the fax pages" in line 3. There is insufficient antecedent basis for this limitation in the claim.

- Claim 6 recites the limitation "the second email information" in line 2. There is insufficient antecedent basis for this limitation in the claim.

- Claim 15 recites the limitation "the failed fax pages" in line 8. There is insufficient antecedent basis for this limitation in the claim.

- Claim 18 recites the limitation "the failed fax pages" in line 8. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Bloomfield (U.S. Patent No. 6023345).

- With respect to claims 1, 3-4, 15, & 17-18, Bloomfield teaches an email/fax communication system for use in a packet switching network environment (e.g. Fig. 1 shows) including a mail server (block 112 in Fig. 1) for storing email messages (e.g. block 210 in Fig. 3) for transmission thereof, in the form of a fax document, to one or more recipient fax machines (e.g. block 102 in Fig. 1), comprising: a router for receiving a first email message, in the form of packets, from the mail server (e.g. block 104 in Fig. 1), for converting the first email message packets to original fax pages of a fax document (col. 7, lines 20-27), for transmitting a first fax pages to a recipient fax machine and upon failure to successfully transmit at least one of the first fax pages of the fax document to the recipient fax machine, transmitting one or more of the first

email message packets to a destination other than the recipient fax machine (see bridge paragraph between col. 1 & 2).

- With respect to claims 2, & 5-6, Bloomfield also teaches wherein the first email message includes first envelope information, in the form of packets, having a destination field for identifying the recipient fax machine (e.g. Figs. 4 & 5 show).

- With respect to claims 7, 9 & 16, Bloomfield teaches wherein the first/secondary envelope information includes a source field for identifying the source of the first email message and a header field for identifying subject matter of the first email message (e.g. Fig. 4 & 5 and col. 8, lines 30-67).

- With respect to claims 8 & 10, Bloomfield discloses wherein the destination field of the first envelope information is a "To:" field (e.g. 283 in Fig. 4).

- With respect to claims 13 & 14, Bloomfield teaches wherein the router further for storing a particular fax page therein until the particular fax page is successfully transmitted to the recipient fax machine (e.g. the E-Mail server 112 receives email from the network 116 and stores in memory 140 to transmit to the fax devices).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mahalingham et al. (U.S. Patent No. 6314525 B1) discloses means for allowing two or more network interface controller cards to appear as one card to an operating system.

- Schuster et al. (U.S. Patent No. 6487690 B1) discloses forward error correction system for packet based real time media.

- Wakasugi (U.S. Patent No. 6411393 B1) discloses apparatus and method of automatically delivering E-mail stored in mail server to arbitrary facsimile apparatus.

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- Mori (U.S. Patent No. 6417930 B2) discloses network facsimile apparatus capable of relaying E-mail to facsimile machine.

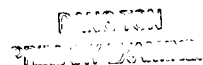
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUC H TRAN whose telephone number is (703) 308-7471. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on (703) 308-5463. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9314.

Phuc Tran  
Assistant Examiner  
Art Unit 2664

P.t  
January 24, 2003



**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes **incorporated** therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.